

DISCUSSION OF THE AMENDMENT

The specification has been amended by capitalizing various names identified by the Examiner as trademarks, and by providing antecedent basis for original Claim 5.

Claim 10 has been amended into Jepson format, and for purposes of clarification.

No new matter is believed to have been added by the above amendment. Claims 1-10 remain pending in the application.

REMARKS

The rejections of:

Claims 1-3, 5, 9 and 10 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over, JP 61-203463 (Machida), as evidenced by *Grant & Hackh's Chemical Dictionary*, page 14 (Dictionary), Schaffert, *Electrophotography*, page 604, Fig. 248, and “applicants’ admission at page 3, lines 10-16, page 11, line 23, to page 12, line 1, and in Table 1 at page 22, of the instant specification (applicants’ admission I)”;

Claim 4 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over, JP 61-203463 (Machida), as evidenced by Dictionary and “applicants’ admission I”;

Claim 6 under 35 U.S.C. § 103(a) as unpatentable over Machida, as evidenced by Dictionary and “applicants’ admission I”, combined with U.S. 6,383,705 (Aoki et al); and

Claims 7 and 8 under 35 U.S.C. § 103(a) as unpatentable over Machida, as evidenced by Dictionary and “applicants’ admission I”, combined with U.S. 5,079,123 (Nanya et al), are all respectfully traversed.

Claim 1 is drawn to a toner for electrostatic image development, comprising a resin binder; and a colorant comprising a charcoal powder, wherein the charcoal powder has a volume-based median particle size (D_{50}) of 5.6 μm or less, and a coefficient of variation (CV) of 80% or less.

Machida discloses a toner containing a binder resin, colorant, and activated carbon as a black pigment. Machida exemplifies an activated carbon, identified in the English translation as “sold as Shirawashi A-1 by Takeda Pharmaceutical Industries K.K.”¹ (page 8). Machida discloses that the particle size of his activated carbon should be approximately 5 μm

¹ The Examiner erroneously finds that the correct product name is “Shiragashi A-1.”

or less (page 4, lines 5-7). According to Table 3 therein, the particle diameter of the exemplified activated carbon is 4.5 μm . Since Machida discloses that using Shirawashi A-1 as a toner results in, *inter alia*, good fine line reproducibility, the Examiner finds that Shirawashi A-1 must meet the volume-based median particle size (D_{50}) and coefficient of variation (CV) limitations of the present claims, since the comparative data of record herein shows that using activating carbon that does not meet both the D_{50} and CV limitations of the claims results in poor fine line reproducibility.

In reply, while the Examiner refers to the above-discussed commercial product as “Shiragashi A-1”, the actual product is Shirasagi A-1, as confirmed by the newly-submitted Moriyama Declaration. In addition, according to the Moriyama Declaration, it appears that the material exemplified as the activated carbon in Machida was pulverized before use. It is impossible to determine what the CV was for the material used in Machida. In effect, Machida is insufficiently disclosed with regard to CV, and one skilled in the art practicing Machida would be without a clue regarding any significance of CV. Indeed, the Moriyama Declaration demonstrates that a CV above 80% results in poor background fogging and thin-line reproducibility.

Regarding “applicants’ admission I”, it is not proper for the Examiner to equate qualitative expressions of results, such as “good” and “poor” thin-line reproducibility between the specification herein, and the prior art, to find that means to obtain the results are quantitatively the same, such as a CV of 80% or less. There is no indication that the respective standards of measurement for the present invention and Machida are the same.

Nor is it proper for the Examiner to use Applicants’ own comparative data, which is not prior art, against them. Indeed, such use has a chilling effect on the submission of any comparative data intending to demonstrate patentability, as the Examiner could not have entered the present rejection if such data had not been disclosed.

The remaining prior art does not render the above-discussed deficiencies of Machida, since it discloses and suggests nothing with regard to CV of a charcoal powder colorant.

For all the above reasons, it is respectfully requested that the rejections over prior art be withdrawn.

The rejection of Claim 10 under 35 U.S.C. § 112, second paragraph, as indefinite, is respectfully traversed. Indeed, it would appear that the rejection is now moot in view of the above-discussed amendment. Accordingly, it is respectfully requested that the rejection be withdrawn.

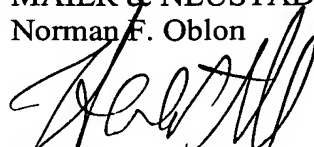
The objection to the specification as lacking proper antecedent basis for Claim 5 is respectfully traversed. Indeed, the objection is now moot in view of the above-discussed amendment. Accordingly, it is respectfully requested that the objection be withdrawn.

The objection to the disclosure in failing to capitalize trademarks is respectfully traversed. Indeed, the objection is now moot in view of the above-discussed amendment. Accordingly, it is respectfully requested that the objection be withdrawn.

All of the presently-pending claims in this application are now believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon



Harris A. Pitlick
Registration No. 38,779

Customer Number
22850
Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)

NFO:HAP\la